UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,463	03/29/2004	Thomas J. Foster	H10357/JDP	3160

1333 7590 12/09/2008

EASTMAN KODAK COMPANY
PATENT LEGAL STAFF
343 STATE STREET
ROCHESTER, NY 14650-2201

EXAMINER	
EBRAHIMI DEHKORDY, SAEID	

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
12/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/812,463	FOSTER ET AL.	
	Examiner	Art Unit	
	SAEID EBRAHIMI DEHKORDY	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1, 7, 14 and 20 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,975,411. Although the conflicting claims are not identical, they are not patentably distinct from each other because for instance the limitation of "comprised of an array of pixels and wherein each pixel is assigned a digital value representing marking information" is mapped to the limitation of "comprised of an array of pixels wherein each pixel is assigned a digital value representing marking information" and the limitation of "defining each pixel as either a background pixel, .interior pixel, or an edge pixel" of claim 1 of the present invention is mapped to the limitation of "defining each pixel as either a background pixel, interior pixel, or an edge pixel of the said patent, and the limitation of "reassigning the digital value of one or more edge pixels or interior pixels independently" is

mapped to the limitation of "reassigning the digital value of one or more of edge pixels or interior pixels independently" of the said patent.

Claims 2-6, 8-13, 15-19 and 21-26 of the present invention are the obvious variant of the claims 2-6, 8-12, 14-18 and 20-24 of the said patent.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsukubo et al (Pub. No.: US 20030038952)

Regarding claim 1 Matsukubo et al disclose: A method of altering the appearance of an input digital image when printed (note page 5, paragraph 0119) the digital image comprised of an array of pixels and wherein each pixel is assigned a digital value representing marking information (note pages 2, paragraph 0028 and page 5, paragraph 0122) the method comprising the steps of: defining each pixel as either a background pixel, interior pixel, or an edge pixel (note page 2, paragraphs 0043, 0044, 0045, 0046 and page 5, paragraph 0122, also note page 9, paragraph 0201) and, reassigning the digital value of one or more edge pixels or interior pixels independently (note page 5, paragraphs 0125-0127 and 0129).

Regarding claim 2 Matsukubo et al disclose: A method in accordance with claim 1, wherein the

digital image is a binary image (note page 5, paragraphs 0119-0121)

Regarding claim 3 Matsukubo et al disclose: A method in accordance with claim 1, wherein the digital image is a multi-bit image (note page 1, paragraph 0007).

Regarding claim 4 Matsukubo et al disclose: A method in accordance with claim 1, wherein the reassigning step comprises increasing the value of edge pixels with respect to interior pixels (note page 5, paragraph 0128, page 9, paragraph 0201).

Regarding claim 5 Matsukubo et al disclose: A method in accordance with claim 1, wherein the reassigning step comprises decreasing the value of edge pixels with respect to interior pixels (note page 5, paragraphs 0127 and 0129, page 9, paragraph 0201).

Regarding claim 6 Matsukubo et al disclose: A method in accordance with claim 1, further comprising performing the defining and reassigning steps two or more times (note page 5, paragraphs 0126-0128).

Regarding claim 7 and 14 Matsukubo et al disclose: A method of printing an image (note page 2, paragraphs 0012&0025) comprising the steps of: converting the image into a digital bitmap (note page 2, paragraph 0027) comprised of an array of pixels wherein each pixel is assigned a digital value representing marking information (note page 2, paragraphs 0027-0028) defining each pixel as either a background pixel, interior pixel, or an edge pixel (note page 2, paragraphs 0043-0046 and page 5, paragraph 0122, page 9, paragraph 0201). and, reassigning the digital value of one or more edge pixels or interior pixels independently, thereby altering the appearance of the image when printed (note page 5, paragraphs 0125-0129, also note page 5, paragraph 0119).

Regarding claim 8 Matsukubo et al disclose: A method in accordance with claim 7, wherein the

converting step comprises converting the image to a binary digital bitmap and the reassigning step comprises reassigning the binary digital values to multi-bit digital values (note page 5, paragraphs 0119-0121).

Regarding claim 9 Matsukubo et al disclose: A method in accordance with claim 7, wherein the converting step comprises converting the image to a multi-bit digital bitmap and the reassigning step comprises reassigning the binary digital values to multi-bit digital values (note page 5, paragraphs 0119-0121).

Regarding claim 10 Matsukubo et al disclose: A method in accordance with claim 7, wherein the reassigning step comprises increasing the value of edge pixels with respect to , page 9, paragraph 0201 pixels (note page 5, paragraph 0128).

Regarding claim 11 Matsukubo et al disclose: A method in accordance with claim 7, wherein the reassigning step comprises decreasing the value of edge pixels with respect to , page 9, paragraph 0201 pixels (note page 5, paragraphs 0127, 0129).

Regarding claim 12 Matsukubo et al disclose: A method in accordance with claim 7, further comprising performing the defining and reassigning steps two or more times (note page 5, paragraphs 0127-0129).

Regarding claim 13 Matsukubo et al disclose: The method of claims 1 or 7 wherein the reassigning step further comprises reassigning the digital value of interior pixels (note page 5, paragraph 0126).

Regarding claim 15 Matsukubo et al disclose: An apparatus in accordance with claim 14, wherein the digital image is a binary image (note page 5, paragraphs 0119-0121)

Regarding claim 16 Matsukubo et al disclose: An apparatus in accordance with claim 14,

wherein the digital image is a multi-bit image (note page 1, paragraph 0007).

Regarding claim 17 Matsukubo et al disclose: An apparatus in accordance with claim 14, wherein reassigning comprises increasing the value of edge pixels with respect to , page 9, paragraph 0201 pixels (note page 5, paragraph 0128).

Regarding claim 18 Matsukubo et al disclose: An apparatus in accordance with claim 14, wherein reassigning comprises decreasing the value of edge pixels with respect to , page 9, paragraph 0201 pixels (note page 5, paragraphs 0127 and 0129).

Regarding claim 19 Matsukubo et al disclose: An apparatus in accordance with claim 14, wherein the rendering circuit further comprises performing defining and reassigning two or more times (note page 5, paragraphs 0127-0129).

Regarding claim 20 Matsukubo et al disclose: An apparatus for printing an image (note page 4, paragraph 0091) comprising: a raster image processor (note page 2, paragraph 0007, lines 22-28) for converting the image into a digital bitmap comprised of an array of pixels wherein each pixel is assigned a digital value representing marking information (note page 2, paragraph 0028 and page 1 paragraph 0007, also note page 10 paragraph 0228) a rendering circuit for defining each pixel as either a background pixel, interior pixel, or an edge pixel (note page 2, paragraphs 0043-0046 and page 5, paragraph 0122) and, reassigning the digital value of one or more edge pixels or interior pixels independently, thereby altering the appearance of the image when printed (note page 5, paragraphs 0125-0127 and 0129).

Regarding claim 21 Matsukubo et al disclose: An apparatus in accordance with claim 20, wherein converting comprises converting the image to a binary digital bitmap and reassigning comprises reassigning the binary digital values to multi-bit digital values (note page 5,

paragraphs 0119-0121).

Regarding claim 22 Matsukubo et al disclose: An apparatus in accordance with claim 20, wherein converting comprises converting the image to a multi-bit digital bitmap and reassigning comprises reassigning the binary digital values to multi-bit digital values (note page 5, paragraphs 0119-0121).

Regarding claim 23 Matsukubo et al disclose: An apparatus in accordance with claim 20, wherein reassigning comprises increasing the value of edge pixels with respect to , page 9, paragraph 0201 pixels (note page 5, paragraph 0128).

Regarding claim 24 Matsukubo et al disclose: An apparatus in accordance with claim 20, wherein reassigning comprises decreasing the value of edge pixels with respect to , page 9, paragraph 0201 pixels (note page 5, paragraphs 0127 and 0129).

Regarding claim 25 Matsukubo et al disclose: An apparatus in accordance with claim 20, wherein the rendering circuit performs performing the defining and reassigning two or more times (note page 5, paragraphs 0126-0128).

Regarding claim 26 Matsukubo et al disclose: The apparatus of claims 14, wherein reassigning further comprises reassigning the digital value of interior pixels (note page 5, paragraphs 0127 and 0129).

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 are rejected under ***35 U.S.C. 101*** as not falling within one of the four statutory categories of invention.

While the claims recite a series of steps of cats to be performed, a statutory "process" under 35 U.S.C 101 must (1) b tied to another statutory category (such as an article or material) to a different state of thing (Reference the may 15,, 2008, memorandum issued by Deputy commissioner for patent Examiner policy, John J Love, titled "Clarification of processes" under 35 U.S.C. 101"- Publicly available at USPTO, GOV, "memorandum to examining corp."). This instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. In order for a process to be "tied" to another statutory category, the structure of another statutory category should be positively recited in a step of steps significant to the basic inventive concept, and NOT just in association with statements of intended use or purpose, Insignificant pre or post solution activity, or implicitly.

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeid Ebrahimi-dehKordy whose telephone number is 571-272-7462. The examiner can normally be reached on Mon-Fri,8:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information

regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sacid Ebrahimi-dehKordy/
Primary Examiner, Art Unit 2625
November 26, 2008